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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/381,742 10/13/99 WHITE, JR.

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EXAMINER

ALVAREZ, R

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

02/14/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/381,742

Applicant(s)

White

Examiner

RAQUEL ALVAREZ

Group Art Unit

2162



☒ Responsive to communication(s) filed on Nov 18, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-168 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 65-75, 82-87, 94-123, 138-140, 153-157, 163-165, and 168 is/are allowed.

☒ Claim(s) 52-64, 76-81, 88-93, 124-128, 130-136, and 142-152 is/are rejected.

☒ Claim(s) 129 and 137 is/are objected to.

☒ Claims 1-51, 56-64, 141, 148-152, and 158-167 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2162

### DETAILED ACTION

1. Claims 1-168 are presented for examination.
2. Claims 1-51, 56-64, 141, 148-152, 159-162, 163-168 are withdrawn for consideration based on the Applicant's election with traverse.
3. Claims 52-55, 65-140, 142-147, 153-158, 163-165 and 168 are presented for examination.

### Election/Restrictions

4. Restriction is required under 35 U.S.C. 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

I. Claims 52-55, 65-140, 142-147, ~~153-158~~ and 168 drawn to set of rules governing the execution and the publishing of trade, classified in class 705, subclass 37.

II. Claims 1-51, 56-64 and 167 drawn to permitting unknown persons to receive detailed information about an offer, classified in class 705, subclass 74.

III. Claims 141, 148-152, drawn to setting the price for the offer, classified in class 705, subclass 400.

IV. Claims 159-166, drawn to usage or charge determination, classified in class 705, subclass 52.

Art Unit: 2162

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as permitting unknown or anonymous user to receive information about an offer. See MPEP § 806.05(d).

6. The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as determining the price for the offer. See MPEP § 806.05(d).

7. The inventions are distinct, each from the other because of the following reasons:

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as determining the price for the usage of the system. See MPEP § 806.05(d).

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

Art Unit: 2162

9. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I, restriction for examination purposes as indicated is proper.

11. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group I, restriction for examination purposes as indicated is proper.

12. Applicant has elected claims 52-55, 65-140, 142-147, 153-158, 163-165 and 168 with traverse.

**Claim Rejections - 35 U.S.C. § 101**

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 130 is directed to non-statutory subject matter. Claim 130 recites a data stream. However, the data does not impact functionality to either the data as claimed or to the computer. As such, the claimed invention recites non-functional descriptive material, i.e. mere data. Non-functional descriptive material stored on a computer-readable medium is merely carried on the

Art Unit: 2162

medium, it is not structurally and functionally interrelated to the medium. The allowance of such a claim would exalt form over substance. For the above mentioned reason, claim 130 is deemed non-statutory.

**Claim Rejections - 35 U.S.C. § 103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52-55, 124-128, 131-134, 135, 136 and 142-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley, Jr.(4,677,552 hereinafter Sibley, Jr.).

With respect to claims 52 and 53, Sibley, Jr. teaches a method for interacting with an offer matching system(abstract). Communicating from a first disclosee to a first participant a first description of the first offer, the first disclosee is not the same as the first participant(i.e. a first disclosee(investor) discloses to the first participant(local exchange) a description of a first offer)(Figure 1); communicating from the first participant to the offer matching system a second description of the first offer (i.e. the local exchange(first participant) communicates the offer information and description on the first offer to the central exchange host(matching system)(col.

Art Unit: 2162

5, lines 34-51); communicating from a second participant to the offer matching system a description of a second offer (i.e. the World trade or central exchange(matching system) receives information from the other local exchange on different trading positions(selling) for a particular commodity(col. 7, lines 7-, col. 8, lines 1-7); communicating from the first disclosee to the first participant a first request for information concerning the first offer(i.e. the disclosee obtains information concerning the status of the first offer from the local exchange(first participant))(col. 5, lines 34-51); In response to the first request, communicating from the first participant to the offer matching system a second request for information concerning the first offer(i.e. the local exchange communicates with the offer matching system for update information on the first offer(col. 5, lines 14-51).

With respect to the offer matching system executing the first offer at least In part against the second offer In accordance with a set of rules that govern the operation of the offer matching system. Since, the World trade or central exchange host(matching system) receives information on different trading positions some for buy and some for sale and the since the central exchange host completes the transaction based on the matches found for that particular trade then it would have been obvious for the matching system to have a set of rules that govern the operation of the offer matching system because such a modification would allow for consistent In the matching process.

With respect to communicating from the offer matching system to the first diclosee a first response In response to the second request of a first data item responsive to the first request and a

Art Unit: 2162

first digital signature from the offer matching system. Sibbley, Jr. further teaches a response from the offer matching system to the disclosee(investor) In response to the information requested by the disclosee(col. 7, lines 35- to col. 10 lines 1-66). Since, Sibbley, Jr. teaches that the Central exchange host can restrict security by a variety of means such as requesting retinal, finger print verification which will include encryption/decryption circuits(col. 8, lines 38-44 and col. 9, lines 45-53) then it would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included requesting a first digital signature In order to achieve the above mentioned advantages.

With respect to claim 54, since the disclosee obtains information concerning the status of the first offer from the local exchange when a change In the offer has been taken place then it would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included responding to the request when a change In the offer has taken place because such a modification would save time by only responding to the request when changes have occurred to the offer.

With respect to claim 55, since the first data item is responsive to the information requested by the disclosee on changes and modifications and changes to the offer and since the second offer is to be matched with the first offer to find out if a offer can be executed then it would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included selecting a predetermined relationship between the first data item and the second offer to obtain the above mentioned advantages.



Art Unit: 2162

125- 129 130  
With respect to claims 124, 125, 127, 128, 131, 132, 134, 135 and 136, Sibley, Jr. teaches receiving from a first participant a first description of the first offer(Figure 1); receiving from a second participant a description of a second offer(i.e. the World trade or central exchange(matching system) receives information from the other local exchange on different trading positions(selling) for a particular commodity(col. 7, lines 7-, col. 8, lines 1-7)

With respect to the offer matching system's executing the first offer at least In part against the second offer In accordance with a set of rules that govern the operation of the offer matching system. Since, the World trade or central exchange host(matching system) receives information on different trading positions some for buy and some for sale and the since the central exchange host completes the transaction based on the matches found for that particular trade then it would have been obvious for the matching system to have a set of rules that govern the operation of the offer matching system because such a modification would allow for consistent In the matching process.

With respect to associating a first offer with a first identifier, the first identifier not associated with any offer other than the first offer. Since the participant can have access to the offer submitted and since it is old and well known practice to assign identifier In the forms of names and ID's to items to enable easy identification then it would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included associating an offer with a first identifier and not associated with any offer other than the first offer because such a modification would provide easy identification of the offers.

Art Unit: 2162

With respect to publishing the execution of the offer. Official notice is taken that is old and well known to publish the execution certain items, for example when a home is sold the price and the location is published and it becomes public information. It would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have published the execution of the offer because such a modification would provide the public with an idea of the sales prices of the items.

With respect to claim 126, since the first data item is responsive to the information requested by the disclosee on changes and modifications and changes to the offer and since the second offer is to be matched with the first offer to find out if a offer can be executed then it would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included selecting a predetermined relationship between the first data item and the second offer to obtain the above mentioned advantages.

With respect to claim 133, the claim further recite associating a second offer with a second identifier, the second identifier not associated with any offer other than the second offer. Since the participant can have access to the offer submitted and since it is old and well known practice to assign identifier In the forms of names and ID's to items to enable easy identification then it would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included associating an offer with a second identifier and not associated with any offer other than the second offer because such a modification would provide easy identification of the offers.

Art Unit: 2162

Claim 134 further recites that the first data item specifies a price at which the first offer was executed against the second offer. Official notice is taken that is old and well known to publish the execution certain items, for example when a home is sold the price and the location is published and it becomes public information. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included specifying a price at which the first offer was executed against the second offer because such a modification would provide the public with an idea of the sales prices of the items.

Claim 142 further recites refusing to execute the first offer against any other offer until it determines that the message is from the first monitor. Since, Sibley teaches that monitor can have access to the execution and process of the offers by identifying themselves to the offer matching system then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included determining the message is from a first monitor and not to execute the offer against any other offer until it determines that the message is from the first monitor for security reasons.

With respect to claim 143, Sibley further teaches determining a minimum price that is the lowest price at which the sell offer may be executed (i.e. In Fig 9 it shows the quantity that can be traded at that particular price for an specific security or item) and determining a maximum price that is the highest at which the buy offer may be executed against the sell offer, wherein the maximum price is greater than the minimum price (i.e. the buyer specifies the maximum quantity and price that he is willing to pay for a particular commodity, the maximum price is greater than

Art Unit: 2162

the minimum price and In which the buy offer may be executed is greater than the minimum price that is greater than the minimum at which the offer can be executed then the offer will be matched and executed). With respect to selecting a first price that is indicative of recent trading activity for the traded item and executing the sell offer at a maximum price if the first price is greater than the maximum price. Since, In Sibbley the buyer selects a first price then it would have been obvious to a person of ordinary skill int the art at the time of Applicant's invention to have included the selected price to be indicative of recent trading activity because such a modification would enable the buyer to be informed with the recent trading activity of the item before selecting the minimum and price that he is willing to pay. Sibbley like any other trading, exchange system teaches that the offer will be executed if the first price(buy price) is greater than the maximum price that the customer is willing to trade his item for.

Claims 144-147 recite specify information that would be beneficial to the buyer to obtain In order to determine a first price that he is willing to pay. It would have been obvious to a person of ordinary skill In the art at the time of Applicant's invention to have included the details of previously executed trade because such a modification would aid the buyer In determining a first price based on the prior history of the executed trades.

**Allowable Subject Matter**

15. Claims 129 and 137 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten In independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2162

With respect to claims 129 and 137, the Examiner asserts that calculation of the second data item depends upon a third data item that is not obtained from the offer matching system, In combination with the other limitations is not taught In the prior art of record.

16. Claims 65-75 and 164-165 are allowed.

With respect to claims 76-81, the Examiner asserts that the first data item concerns the first offer, and before receiving the first data item, the first disclosee does not posses information which discloses that the first data item concerns the first offer, whereby the first discloser, which already possesses information which discloses that the first related person satisfies the first condition, gains possession of information which discloses that the first data item concerns the first offer, is not taught In the prior art of record.

With respect to claims 65-75, 82-87, ~~101-108~~, 101-117, 163-165 and 168, the Examiner asserts that at a time when the first offer was capable of execution, the third offer executed In whole or In part against a fourth offer, wherein the fourth offer is not the first offer, and that at a first time when the first offer was capable of execution: the third offer executed In whole or In part against a fifth offer, wherein the fifth offer is not the first offer, and the first offer could have executed In whole or In part against the fifth offer In accordance with the set of rules if the offer matching system had not possessed information concerning any other offers for a same side as the first offer; and In response to the first request, and without the offer matching system's determining that the first request is from a person entitled to receive confidential information

Art Unit: 2162

concerning the third offer, In combination with the other limitations is not taught In the prior art of record.

With respect to claims 94-100, the Examiner asserts that the second data packet is published In a manner that permits the first disclosee to receive it regardless of whether the first disclosee has a right to receive confidential information concerning the first offer, and prior to publication of the second data packet, the first disclosee does not possess information which discloses that the second data item concerns the first offer; the first disclosee's receiving the second data packet and detecting that the second data packet includes the first identifier, whereby the first disclosee, which already possesses information which discloses that the first related person satisfies the first condition, gains possession of information which discloses that the first data item concerns the first offer, In combination with the other limitations is not taught In the prior art of record.

With respect to claims 118-123, the Examiner asserts that the first data item concerns the first offer, and the monitor does not already possess information which discloses that the first data item concerns an offer that satisfies the first condition, whereby the first monitor gains information which discloses that the first data item concerns an offer that satisfies the first condition; and attempting to avoid publicly disclosing that the first data item concerns an offer that satisfies the first condition, is not taught In the prior art of record.

With respect to claim 138-140, the Examiner asserts that after receiving the first description but before the offer matching system determines that the future time has occurred,

Art Unit: 2162

executing the second offer at least In part against the third offer, wherein, if the offer matching system had already determined that the future time had occurred, the second offer would have had a lower execution priority than the first offer and the offer matching system would not have executed the second offer even In part against the third offer, is not taught In the prior art of record.


With respect to claims 153-157, the Examiner asserts that a method for securely communicating with a server program using a secure hypertext transfer protocol, the server program is configured so that it listens for requests for secure hypertext transfer protocol sessions on the second port number rather than the first port number and outputting from the server program a response to the first data packet In a manner that is consistent with the secure hypertext transfer protocol, except that the request was received on the second port number rather than the first port number, In combination with the other limitations of the claim is not taught In the prior art of record.

**Points Of Contact**

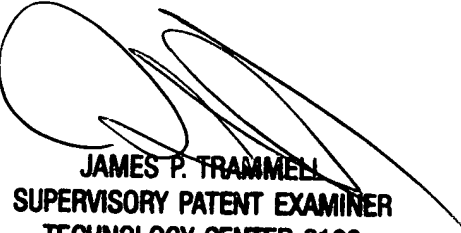
17. Any inquiry concerning this communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703) 305-0456. The examiner can normally be reached on Monday to Friday from 9:00 AM. To 5:00 PM.

Art Unit: 2162

If any attempt to reach the examiner by telephone is unsuccessful, The examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for this group is (703) 305-0040.

  
Raquel Alvarez  
Patent Examiner, AU 2162

February 9, 2001

  
JAMES P. TRAMMELL  
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